

REMARKS

This is a full and timely response to the non-final Official Action mailed May 22, 2002 (Paper No. 2). Reconsideration of the application in light of the above amendments and the following remarks is respectfully requested.

By the forgoing amendment, claims 12 and 16 have been amended. Additionally, new claims 22-25 have been added. No claims have been cancelled. Thus, claims 1-25 are currently pending for the Examiner's consideration.

In the outstanding Office Action, the Examiner rejected the claimed invention based on a variety of prior art references, taken both alone and in various combinations. The rejected independent claims are claims 1, 12, 16 and 21. Applicant will primarily address the rejection of these independent claims.

The Examiner rejected claims 1, 8, 9, 11, 16, 18 and 19 as anticipated under 35 U.S.C. § 102(b) by Cooledge et al. ("Cooledge"). For at least the following reasons, this rejection is respectfully traversed.

Claim 1 recites:

A method of making a user-customized electrostatic sticker, said method comprising printing a user-selected image on sticker print medium, said sticker print medium being of a non-conductive material on which an electrostatic charge can be maintained such that said sticker print medium functions as an electrostatic sticker.

In contrast, Cooledge fails to teach printing a "user-selected image" on a sticker print medium. Cooledge expressly refers to the image on the described "wall coverings" as a "preprinted image." (Cooledge, abstract). Thus, the image printed on the Cooledge wall coverings is manufacturer-selected and *not* user-selected. The user does not select an image and print that image on the sticker, as claimed. Rather, in Cooledge, the user buys a "preprinted" wall covering.

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Consequently, Cooledge cannot anticipate the invention of claim 1 or render claim 1 unpatentable. Thus, the rejection of

claim 1 and its dependent claims, based solely on Cooledge, should be reconsidered and withdrawn.

Claim 16 recites:

An electrostatic sticker kit comprising:
at least one blank sheet of an electrostatic sticker print medium; and
a charge donor, other than said sticker print medium, for depositing an
electrostatic charge on either side of said sticker print medium after said sticker print
medium has been printed with an image;
wherein said at least one blank sheet of sticker print medium and said charge
donor are associated together in said kit.

(emphasis added).

As disclosed in Applicant's specification at paragraph 66, the claimed "charge donor," is different and separate from the sticker print medium itself, and can be a variety of materials capable of adding a charge to the sticker print medium. (Spec., para. 66).

In contrast, Cooledge teaches that an electrical charge is developed by friction when the print medium is moved over or against itself. (Col. 4, lines 1-4). Consequently, Cooledge fails to teach or suggest the claimed sticker kit that comprises both a sheet of sticker print medium and a charge donor other than the print medium itself.

"A claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Consequently, Cooledge cannot anticipate the invention of claim 16 or render claim 16 unpatentable. Thus, the rejection of claim 16 and its dependent claims, based solely on Cooledge, should be reconsidered and withdrawn.

Furthermore, Applicant believes that the prior art of record, taken in any combination, fails to teach or suggest the sticker kit as recited in claim 16. Therefore, allowance of claim 16 and all claims that depend therefrom is requested.

The Examiner also rejects claims 12-15 as anticipated under 35 U.S.C. § 102(b) by Longtin ("Longtin"). For at least the following reasons, this rejection is respectfully traversed.

Claim 12 recites:

An electrostatic sticker print medium for use with a printer, said sticker print medium comprising:
a blank sheet of electrostatic print medium;
an electrostatic charge deposited on a side of said sticker print medium; and
a protective backing over said electrostatic charge on said blank sheet of electrostatic print medium.

In contrast, Longtin teaches a roll (10) of printed stickers (30). Each sticker (30) is backed by a release liner (40), and the liners (40) are stuck on a carrier substrate (20).

Longtin does not teach or suggest a “blank” sheet of electrostatic print medium. The Examiner argues that each of the stickers (30) was “inherently blank before it was printed upon.” (Paper No. 2, p. 3). This may be true, but is irrelevant to the claimed invention and does not allow Longtin to anticipate the invention of claim 12.

Claim 12 recites both (1) a blank sheet of electrostatic print medium and (2) a backing on the blank sheet of print medium. There is no teaching or suggestion in Longtin that the release liner (40) is applied to the print medium or stickers (30) *before* the stickers are printed.

Consequently, Longtin and the other prior art of record fail to teach or suggest the claimed print medium, which is blank but also has a protective backing over an electrostatic charge. As noted before, “[a] claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Consequently, Longtin cannot anticipate the invention of claim 12 or render claim 12 unpatentable. Thus, the rejection of claim 12 and its dependent claims, based solely on Longtin, should be reconsidered and withdrawn.

The Examiner also rejects claims 20-21 as anticipated under 35 U.S.C. § 102(b) by Suzuki et al. (“Suzuki”). For at least the following reasons, this rejection is respectfully traversed.

Claim 20 recites:

A system for producing user-customized electrostatic stickers, said system comprising:

a host computer for generating a user-selected image;
a printer connected to said host computer for receiving print data
corresponding to said user-selected image; and
a sticker print medium, comprising an electrostatic charge, on which said user-
selected image is printed with said printer to produce said user-customized sticker.

In contrast, Suzuki fails to teach or suggest a sticker print medium as claimed. The Examiner acknowledges this fact, stating that “Suzuki et al. does not disclose printing on an electrostatic print media” (Paper No. 2, p. 4). However, the Examiner goes on to argue that “the material or article worked upon by an apparatus does not further limit the apparatus. See MPEP 2115.” (id.).

In this regard, the Examiner has misread the applicable law as cited by MPEP § 2115. The MPEP, § 2115, actually states that “‘Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim.’ *Ex parte Thibault* 164 USPQ 666, 667.” (emphasis added).

Applicant agrees that if “a printer” were claimed, the inclusion of a specific print medium would not patentably distinguish the claimed printer from a similar printer under the law cited by MPEP § 2115. However, Applicant is not claiming “a printer.” Rather, Applicant is claiming a “system for producing user-customized electrostatic stickers.” Consequently, a supply of sticker print medium is part of, and required by, the “system” and must be given weight in considering the patentability of claim 20.

Thus, when claim 20 is considered in its entirety, and the applicable law is correctly construed, it is clear that Suzuki fails to teach or suggest the system recited by claim 20. Specifically, Suzuki fails to teach or suggest the system for producing customized stickers with a printer printing user-selected images on a supply of sticker print media.

As noted before, “[a] claim is anticipated [under 35 U.S.C. § 102] only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). See M.P.E.P. § 2131. Consequently, Suzuki cannot anticipate the invention of claim 20 or render claim 20 unpatentable. Thus, the rejection of claim 20 and its dependent claims, based solely on Suzuki, should be reconsidered and withdrawn.

The newly added claims, 22-25, are believed to recite subject matter which is patentable over the prior art of record, taken singly or in any combination. Therefore, examination and allowance of the newly added claims is respectfully requested.

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Steven L. Nichols', written over a horizontal line.

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Claims Appendix

For the convenience of the Examiner, and in accordance with 37 CFR 1.121(c)(1)(ii), all pending claims are presented below in their current form. Amendments made by the present paper are indicated with added material being underlined and deleted material being bracketed.

1. A method of making a user-customized electrostatic sticker, said method comprising printing a user-selected image on sticker print medium, said sticker print medium being of a non-conductive material on which an electrostatic charge can be maintained such that said sticker print medium functions as an electrostatic sticker.
2. The method of claim 1, further comprising reversing said user-selected image before said printing said user-selected image on said sticker print medium.
3. The method of claim 2, further comprising reversing said user-selected image with a print driver of a host computer.
4. The method of claim 2, further comprising reversing said user-selected image with firmware of a printer which performs said printing of said user-selected image.
5. The method of claim 1, further comprising providing an electrostatic charge on said sticker print medium prior to said printing of said user-selected image.
6. The method of claim 5, further comprising protecting said electrostatic charge with a protective backing.
7. The method of claim 6, further comprising removing said protective backing and applying said sticker.

8. The method of claim 1, further comprising depositing an electrostatic charge on said sticker print medium with a charge donor after said printing of said user-selected image.

9. The method of claim 1, further comprising perforating one or more sections of said sticker print medium.

10. The method of claim 5, further comprising applying said electrostatic sticker such that a side of said sticker bearing said electrostatic charge is in contact with a surface to which said sticker is applied.

11. The method of claim 8, further comprising applying said electrostatic sticker such that a side of said sticker bearing said electrostatic charge is in contact with a surface to which said sticker is applied.

12. (once amended) An electrostatic sticker print medium for use with a printer, said sticker print medium comprising:
a blank sheet of electrostatic print medium;
an electrostatic charge deposited on a side of said sticker print medium; and
a protective backing over said electrostatic charge on said blank sheet of electrostatic print medium.

13. The sticker print medium of claim 12, wherein said sticker print medium is made of vinyl.

14. The sticker print medium of claim 12, wherein said sheet of electrostatic print medium is transparent.

15. The sticker print medium of claim 12, wherein said sheet of electrostatic print medium is perforated to define a plurality of sticker panes.

16. (once amended) An electrostatic sticker kit comprising:
at least one blank sheet of an electrostatic sticker print medium; and
a charge donor, other than said sticker print medium, for depositing an electrostatic charge on either side of said sticker print medium after said sticker print medium has been printed with an image;
wherein said at least one blank sheet of sticker print medium and said charge donor are associated together in said kit.

17. The sticker print medium of claim 16, wherein said sticker print medium is made of vinyl.

18. The sticker print medium of claim 16, wherein said sheet of electrostatic print medium is transparent.

19. The sticker print medium of claim 16, wherein said sheet of electrostatic print medium is perforated to define a plurality of sticker panes.

20. A system for producing user-customized electrostatic stickers, said system comprising:

a host computer for generating a user-selected image;
a printer connected to said host computer for receiving print data corresponding to said user-selected image; and
a sticker print medium, comprising an electrostatic charge, on which said user-selected image is printed with said printer to produce said user-customized sticker.

21. The system of claim 20, wherein said printer is an inkjet printer.

22. (new) A method of producing a customized electrostatic sticker, said method comprising:

placing a user-selected image on a host computer that is connected to a printer;

supplying a sticker print medium to said printer, said sticker print medium comprising an electrostatic charge maintained on a surface of said print medium by a protective cover disposed over said surface of said print medium; and

driving said printer with said host computer to print said user-selected image on a sheet of said sticker print medium.

23. (new) The method of claim 22, further comprising generating said user-selected image using application software on said host computer.

24. (new) The method of claim 22, wherein said printer is an inkjet printer.

25. (new) A business method comprising providing an electrostatic sticker kit, said providing an electrostatic sticker kit containing at least one blank sheet of an electrostatic sticker print medium and a charge donor, other than said sticker print medium, for depositing an electrostatic charge on either side of said sticker print medium.